

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

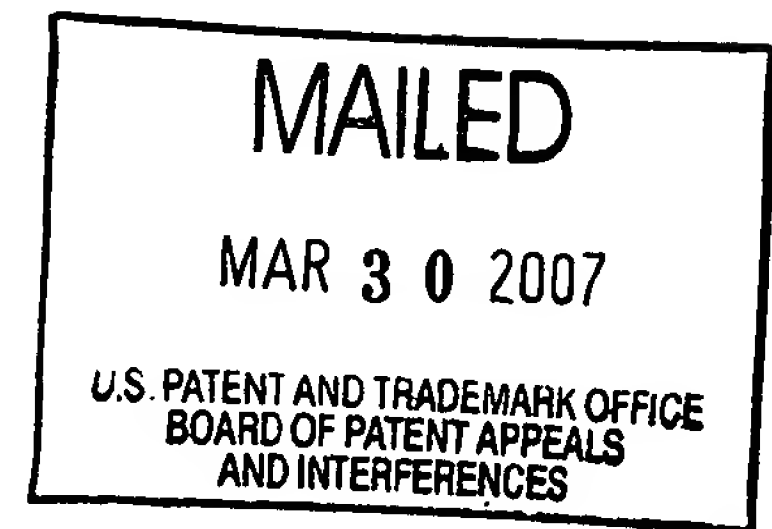
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte John M. Egnor

Appeal 2005-1122
Application 08/828,560
Technology Center 3600

Decided: March 30, 2007



Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and ANTON W. FETTING, *Administrative Patent Judges*.

PATE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-12. These are the only claims in the application. It is noted that the Examiner has omitted claim 5 from the grounds of rejection. We assume that this is an oversight on the Examiner's part and that claim 5 was intended to have been rejected along with the independent claim from which it depends. We include it in

the rejected claims in our decision. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

The claimed invention is directed to a wheel stop for commercial kitchen equipment. The claimed subject matter may be further understood with reference to independent claim 1 appended to Appellant's brief.

The references of record relied upon as evidence of obviousness are:

Wilson et al.(Wilson)	US 2,007,514	Jul. 9, 1935
Gregg	US 2,441,627	May 18, 1948
Rapp	US 2,870,872	Jan. 27, 1959

THE REJECTIONS

In the Examiner's answer mailed July 17, 2003, the examiner has included the following rejections:

Claims 1, 2, 6/1, 6/2, 7, 10, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gregg in view of Rapp.

Claims 3, 4, 5, 6/3, 6/4, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gregg in view of Rapp and Wilson. As noted above, we assume that the Examiner intended claim 5 in this group of claims.

Notwithstanding the Examiner's statement on page 2 of the Examiner's Answer, we do not find a rejection of claim 12 under 35 U.S.C. § 112, second paragraph, at any place in the Answer. Accordingly, we conclude that the any rejection under section 112 has been withdrawn by the Examiner.

For Appellant's arguments with respect to these rejections, reference is made to the appeal brief. Additionally, we note Appellant has furnished declarations in rebuttal of the Examiner's prima facie case of obviousness.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the Appellant and the Examiner. As a result of this review, it is our conclusion of law that claims 1-11 are obvious over the applied prior art. With respect to claim 12, it is our legal conclusion that the claim is so indefinite as to make a proper construction thereof impossible. Accordingly, we enter a rejection of claim 12 under 35 U.S.C. § 112, second paragraph. Our reasons follow.

OBVIOUSNESS

Turning to the obviousness rejections, it is our understanding from the Brief that Appellant does not argue or challenge, in any manner, the Examiner's prima facie case of obviousness, based on the references, as this prima facie case applies to claims 1-11. Instead, Appellant furnishes three declarations under 37 C.F.R. § 1.132 as evidence of secondary considerations. When such evidence is presented, it is our duty to carefully consider all evidence anew. See, for example, *In re Eli Lilly Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1443 (Fed. Cir. 1990). We are also mindful that objective evidence of non-obviousness may be entitled to more or less weight depending upon its nature and its relationship with the merits of the invention. See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1539, 218 USPQ 871, 879 (Fed. Cir. 1983). We will consider the declaration evidence in detail below.

A first declaration is by Marco Whitty. Mr. Whitty is a shift engineer in facilities management at Foxwoods, a casino resort. It is unclear how long Mr. Whitty has held such a position, what his training and formal education

might be, and whether he could be considered either as an expert or one of ordinary skill in the kitchen equipment art.

Mr. Whitty states that he believes “that there is a definite need for the proposed invention....” This testimony appears to be both prospective and forward-looking and in the nature of speculation. The multiple averments that state that the invention *would* solve this or that problem convey to us that Mr. Whitty has not actually used the invention, and for this reason we understand the testimony to be speculative and forward-looking. Apparently it cannot be said to be based on actual experience using the claimed subject matter.

In the next paragraph, Mr. Whitty states he has attempted to solve the problem that the invention would solve. It is difficult to assign a value to this testimony as we cannot ascertain whether Mr. Whitty is one of ordinary skill in the kitchen equipment art. We do credit the portions of the declaration that discuss problems such as non-working fire safety equipment and employee burns. We do not doubt that these are recognized problems Mr. Whitty has witnessed. However, without actually practicing the invention, the assumption that the claimed subject matter is a solution to these problems rests on little actual evidence. For these reasons, the declaration of Mr. Whitty is entitled to but little weight.

A second declaration is by Louis Endsley. Endsley is the Director of Facilities Design and Construction at the Showboat Casino in Atlantic City, New Jersey. While an employment history is given for Mr. Endsley, the information is not put into perspective by explaining how the employment history might relate to the field of the invention. We are unable to determine whether he is an expert or a person of ordinary skill in the kitchen equipment

art. Mr. Endsley, like Mr. Whitty, states that there is a definite need for the proposed invention. He states that he has attempted to solve the problem which Mr. Egnor's invention *would* solve. Here again the averments seem to be prospective in nature. Mr. Endsley does not state that the invention actually does solve the problems associated with kitchen equipment, only that it *would* solve the problem. This again raises the issue of whether the declarant has actually seen the device in operation and can attest that it actually worked to solve the problems.

Lastly, Appellant has provided a third declaration, this declaration by Wallace Shield, a fire protection official for the municipality of Atlantic City, New Jersey. Since Mr. Shield is a public employee, we presume he is a person of ordinary skill in the fire protection art. Mr. Shield states that he believes that there is a definite need for the proposed invention. He states that many installation of kitchen equipment are not located properly, and that the invention "would solve this problem." Here again the evidence offered is speculative and forward-looking in nature. Mr. Shield fails to state that he has seen the invention actually operate to solve the problems he has identified in the industry.

As noted above, the three witnesses do not state that they have seen the invention function and that it does in fact solve the problems they have recognized in the industry. Instead, their evidence is seen to be prospective in nature and based on their speculation that the invention will solve a need in the field of kitchen equipment safety. While the declarations provide some evidence of long-felt need, the bulk of the averments appear to be mere suppositions on the part of the declarants. They present little factual information and appear to be merely laudatory. See *In re Vamco Machine &*

Tool Inc., 752 F.2d 1564, 1574, 224 USPQ 617, 624 (Fed. Cir. 1985) and *Jenn-Air Corp. v. Modern Maid Co.*, 499 F.Supp 320, 209 USPQ 295, 301-02 (D. Del. 1980). The praise set forth in the declarations appears to be evoked by the general concept or overall idea of the invention. At most, the declarations could be said to regard the prospective use of the invention as promising. *Note In re Fielder*, 471 F.2d 640, 646, 176 USPQ 300, 309 (CCPA 1973)(At best, the evidence shows several instances of use and some favorable reaction thereto which holds forth a promise of possible future use). In short, we find that the declarations state Appellant's concept is a good idea and that it *could* be a useful tool. These are merely forward-looking statements based on the *expectations* of the declarants and hardly provide substantial evidence to rebut the *unargued* prima facie case of obviousness established by the Examiner.

Considering all the evidence anew, including the Examiner's prima facie case and all of Appellant's evidence of secondary considerations, it is our legal conclusion that the evidence for obviousness outweighs the evidence against obviousness. The rejections of claims 1-11 are sustained.

Turning to claim 12, we note the following errors and inaccuracies that render the claimed subject matter indefinite within the purview of 35 U.S.C. § 112, second paragraph. In the second line of claim 12, as the line appears in the second page of the claims in Appellant's appendix to the brief, we note there are words missing as represented by the bracket after the clause "shifting of the" and before the comma. On the next page at line 4, it is noted that the letter "d" is missing after the word "space" as the term "space ramps" has not been previously recited. In line 6, after the comma, we are unable to ascertain whether "by application of the displacing

force...” is to be considered another positively recited step in Appellant’s claimed method. Perhaps Appellant means that the application of the displacing force is merely a result. In line 8, on this page, there appears to be text missing after the phrase “downward force on” as represented by the bracketed text. In that same line the expression “such rolling” has no antecedent. In line 9, does the expression “wheel up the ramp” refer to one of the opposed spaced ramps or to a new ramp not previously recited? In line 10, we note the reference to “its wheel.” However, “its wheel” refers back to a clause the subject of which is a wheel. It is doubtful a wheel has another wheel attached thereto. In the last line of the claim it is unclear whether the rigid surface might be the floor recited in the first line of the claim. Finally, it is unclear how the commercial kitchen equipment is secured to the rigid surface by use of the securing means, since there is no recited relationship between the securing means and any other recited structure such as a wheel, etc.

All the words in a claim must be considered in judging the patentability of the claim against the prior art. If no reasonable definitive meaning can be ascribed to certain claim terms the claim does not become obvious—the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Our analysis of the claim indicates that considerable speculation as to the meaning of terms employed therein and assumptions as to the scope of such a claim needs to be made. We do not think a rejection under section 103 should be based on such speculation and assumptions. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Accordingly, we reverse the rejection under 35 U.S.C. § 103 and

Appeal 2005-1122
Application 08/828,560

enter our own rejection under 35 U.S.C. § 112, second paragraph, under the provisions of 37 CFR § 41.50(b).

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The reasons for this rejection are stated above.

CONCLUSION AND ORDER

The rejections of claims 1-11 are affirmed. The rejection of claims 12 under § 103 is reversed. A new rejection of claim 12 has been entered by the Board.

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

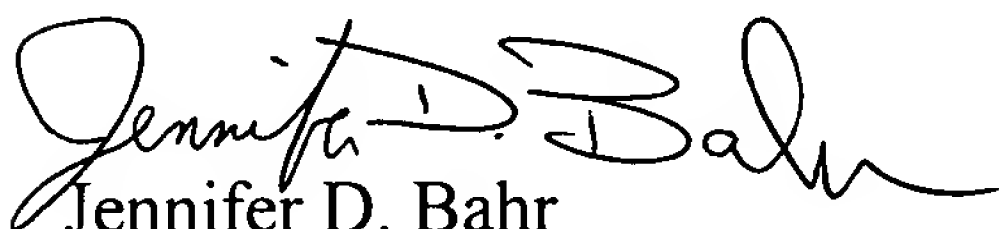
Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

AFFIRMED-IN-PART; REJECTION UNDER 37 CFR § 41.50(b)



William F. Pate, III
Administrative Patent Judge



Jennifer D. Bahr
Administrative Patent Judge



Anton W. Fetting
Administrative Patent Judge

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Appeal 2005-1122
Application 08/828,560

Jim Zegeer
801 North Pitt Street
Alexandria, VA 22314